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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,691	12/15/2000	Vipin Samar	OR00-14201	6542

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PARK, VAUGHAN & FLEMING LLP  
508 SECOND STREET  
SUITE 201  
DAVIS, CA 95616

EXAMINER

SON, LINH L D

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 05/24/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/741,691

Applicant(s)

SAMAR, VIPIN

Examiner

Linh LD Son

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date 2. | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
3. Claims 1-4, 8, 10-15, 17, 19, 21-26, 28, 30, and 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Hardy et al (US/6073242).
4. As per claims 1, 12, and 23, Hardy et al disclose the “Electronic Authority Server” invention, which teaches the apparatus, and a method for facilitating

the delegation of operations involved in providing digital signatures to a signature server (Col 7 lines 10-38), the method comprising:  
initializing a secure connection between the client and the server by using an encrypting link. The user sends the authority server a message including the authorization and the outgoing message to be signed (Col 8 lines 20-52). The authority server will then look up the user signing keys associates to his/her enterprise role, authority (Col 9 lines 18-27). Once the authentication process is completed, the server signs the message (Col 8 line 53 to Col 9 line 49, and Col 9 line 65 – Col 10 line 20).

5. As per claims 2, 13, and 24, Hardy et al disclose the method of claim 1, wherein prior to signing the item, the method further comprises authenticating the user (Col 9 lines 4-31).
6. As per claims 3, 14, and 25, Hardy et al disclose the method of claim 2, wherein prior to signing the item, the method further comprises determining whether the user is authorized to sign the item (Col 8 lines 29-31).
7. As per claims 4, 15, and 26, Hardy et al disclose the method of claim 3, wherein determining whether the user is authorized to sign the item involves looking up an authorization for the user based upon an identifier for the user

as well as an identifier for an application to which the user will send the signed item (Col 8 line 53 to Col 11 line 65).

8. As per claims 6, 17, and 28, Hardy et al disclose the method of claim 1, wherein comprising allowing the user to authenticate the signature server prior to sending the message to the signature server (Col 8 lines 20-35).
9. As per claims 8, 19, and 30, Hardy et al disclose the method of claim 1, wherein the method further comprises configuring the signature server to accommodate a new user by: receiving a request from an authorized entity to add the new user; generating a key pair for the new user, including a new user private key and a new user public key (Col 20 lines 20-45); communicating with a certification authority to obtain a certificate for the new user based on the key pair (Col 20 line 65 to Col 21 line 18); and storing the certificate and the key pair for the new user in the location that is accessible by the signature server to enable the signature server to sign items on behalf of the new user (Col 9 lines 5-35).
10. As per claims 10, 21, and 32, Hardy et al disclose the method of claim 1, wherein the method further comprises archiving the message and the signed item at the signature server (Col 20 lines 15-16).

11. As per claims 11, 22, and 33, Hardy et al disclose the method of claim 1, wherein the method further comprises forwarding the signed item to an archive server in order to be archived (Col 20 line 15).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5, 7, 9, 16, 18, 20, 27, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy et al.
14. As per claims 7, 18, and 29, Hardy et al disclose the method of claim 1, further comprising the returning of the signed item to the user so that the user can send the signed item to a recipient (Col 17 line 40- Col 18 line 57). However, Hardy et al do not specifically teach the user receiving the signed item and then send it later. Nevertheless, Hardy et al disclose the template to send the message (Col 17 lines 40-45), which includes the "from" and "to" field. Therefore, it is obvious at the time of the invention was made for one of ordinary skill in the art to send the message to himself, the recipient, so that the user can receive the signed message for later sending to any destination.

15. As per claims 5, 16, and 27, Hardy et al disclose the method of claim 3, wherein determining whether the user is authorized to sign the item involves communicating with an authority server. However, Hardy et al do not teach the authority server is separated from the signature server. Nevertheless, Hardy et al teach the server (Figure 2, 102) providing many tasks including authentication, maintaining user directory and database, authorizing, encrypting and signing (Col 8 line 53 to Col 9 line 31). It is obvious at the time of the invention was made for one of ordinary skill in the art that the authority and the signing server can be two separate servers.
16. As per claims 9, 20, and 31, Hardy et al disclose the method of claim 1. However, Hardy et al do not teach the method further comprises configuring the signature server to delete an old user by; receiving a request from an authorized entity to delete the old user; notifying a certification authority to revoke a certificate for the old user; and removing the private key for the old user from the signature server so that the signature server can no longer sign items on behalf of the old user. Nevertheless, in Col 10 line 64 to Col 11 line 8, Hardy et al teach the administration method of the users. Therefore, it is obvious at the time of the invention was made for one of ordinary skill in the art to know that the same management method can do the same tasks, such as delete the old user, revoking the certificate, and removing the private key of the old user.

**Conclusion**

17. Any inquiry concerning this communication from the examiner should be directed to Linh Son whose telephone number is (703)-305-8914 or Fax to 703-746-9821.
18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Kim Y. Vu can be reached at (703)-305-4393. The fax numbers for this group are (703)-872-9306 (official fax). Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)-305-9600.

Linh LD Son

Patent Examiner

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100